

REMARKS

Claims 1 to 60 are pending. No additional fees are believed due. However, the Director is hereby authorized to charge any deficit, or credit any overpayment, to Deposit Account No. 08-2525.

Restriction Requirement

The claimed subject matter has been divided by the Patent Office into seven groups as set forth below:

- I. Claims 1 to 20 and 53 to 55, directed to compounds of formula I and II
- II. Claims 21 to 25, directed to compounds of formula Ia
- III. Claims 26 to 42, directed to compounds of formula II
- IV. Claims 43 to 46, directed to compounds of formula IIa
- V. Claims 47 to 52, directed to compounds (apparently considered distinct by the examiner)
- VI. Claims 56 to 58, directed to a method of using the compounds of the invention
- VII. Claims 59 to 60, directed to a process for preparing compounds of the invention

Election of one of these groups for prosecution on the merits has been required. The Office Action indicates that restriction is proper because the compounds have a diverse chemical structure providing different properties, effects, etc.

Applicants elect with traverse Group I, claims 1 to 20 and 53 to 55, directed to compounds of formula I and formula II. The restriction requirement is traversed for at least the following reasons.

First, with respect to Groups I, II, III, IV, and V, the Office Action asserts that each of these groups is recognized in the art as being distinct from one another because of their diverse chemical structure, their different chemical properties, different modes of action, different effects and

reactive conditions. The initial burden is on the Patent Office to establish such differences through evidence or scientific reasoning. Only upon meeting that burden can the listed groups be properly restricted.

The Office Action states that the compounds are structurally diverse. To the contrary, the entire scope of each of Groups II, III, IV, and V is encompassed by Group I. Thus, to the extent that the same compounds are included within these groups, they cannot be considered structurally diverse.

The Office Action further states that the compounds employed in the invention have different chemical properties, different modes of action, and different effects. However, the specification teaches that the claimed compounds all are monoamine oxidase β (MAO- β) inhibitors, i.e., the compounds of the invention inhibit the activity of MAO- β . The specification further discloses that because the compounds are MAO- β inhibitors, they are useful for treating central nervous system disorders in which MAO- β has a role. The Office Action further states that a presumption that different chemical structures have different function can be overcome by scientific reasoning and evidence, but, as noted above, the initial burden is on the Patent Office to show that the compounds recited in the claims do not have the similar function taught by the specification. The Patent Office has not provided any evidence to refute the statements in the specification. In the absence of any such evidence, the Examiner must take the statements of common activity in the specification at face value.

Thus, the compounds of Groups II, III, IV, and V are not structurally diverse from those of Group I and do not have different types of activities. Therefore, restriction between these groups of claims is improper.

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Second, as the claims of Group I are generic to the claims of Groups II, III, IV, and V, search and examination of the elected Group I, necessarily results in the search and examination of Groups II, III, IV, and V. Since no additional search or examination over that required for examination of Group I is required for examination of Groups II, III, IV, and V, there is no undue burden on the Patent Office to examine these additional groups with the elected group and restriction between the groups is improper. Therefore, Applicants respectfully request that Groups II, III, IV, and V be rejoined and examined with Group I.

Third, as claim 1 wholly encompasses the subject matter of claims 1 to 52, it is a linking claim that properly links the compounds of formula I and formula II. In accordance with M.P.E.P. § 809.03, Applicants submit that claims 1 to 52 and the corresponding composition claims 53 to 55 should be grouped as follows:

Group I: Claims 7 to 25, 47 to 48, and 54, drawn to compounds and compositions of formula I

Group II: Claims 26 to 46, 49 to 52, and 55, drawn to compounds and compositions of formula II

Applicants further submit that restriction between these two groups is subject to the non-allowance of the linking claims, claims 1 to 6 and 53, that link these two groups.

With regard to Groups VI and VII, Applicants understand that upon the finding of an allowable compound claim, those claims of Groups VI and VII having all of the limitations of the allowable product claim will be rejoined in accordance with M.P.E.P. § 821.04.

Requirement for Election of Species

The Office Action further requires election of a single disclosed species and states that upon election of a single disclosed species, the Office will review the claims and disclosure to

determine the scope of the independent invention encompassing the elected compound. The Office Action further states that a generic concept will then be created by the Examiner and all other subject matter will be withdrawn from examination.

Applicants elect the species 2-[1-oxo-5-(4-trifluoromethyl-benzyloxy)-1,3-dihydro-isoindol-2-yl]acetamide with traverse. Compound and composition claims reading on the elected species are claims 1 to 12, 14, 15, 17, 18, 20 to 25, 47, 53, and 54. The election requirement is traversed for at least the following reasons.

By statute, an applicant has the right to claim his invention with limitations he regards as necessary to circumscribe that invention, so long as the requirements of 35 U.S.C. § 112 are met. *In re Weber*, 198 U.S.P.Q. at 331, citing *In re Wolfram*, 179 U.S.P.Q. 620 (CCPA 1973). Further, applicant has a right to have each claim examined on the merits. The court in *In re Weber* held that the Patent Office must examine a claim on its merits and cannot refuse to examine subject matter within a single claim because such a refusal violates applicant's right to have that claim examined on the merits. In support of its holding, the court determined that if the Patent Office required a single claim to be divided and presented in several applications, the entire claim would never be considered on its merits. In particular, the court found that the totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim and that because the subgenera would be defined by the examiner rather than by the applicant, some of the fragments may not be described in the specification. The court further weighed the right of the Commissioner to divide applications for administrative and search purposes against applicant's right to have his invention examined and held that applicant's rights are paramount. *In re Weber*, 198 U.S.P.Q. at 331-32.

Further, it is noted that 35 U.S.C. § 112, second paragraph, affords applicant the right to claim the subject matter he regards as his invention. Thus, applicants have the right to claim their invention as they contemplate it and to have that invention examined in its entirety. Nothing in 35 U.S.C. § 121, or

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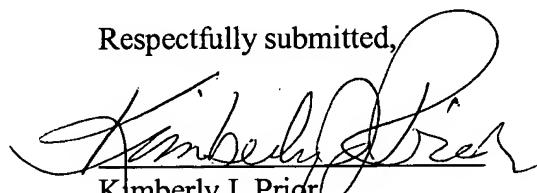
any other statute, affords the Patent Office the right to define applicant's invention as it contemplates. The Office's statement that it will review the claims and disclosure to determine the scope of the independent invention encompassing the elected compound is a clear violation of applicant's right to define his invention under 35 U.S.C. § 112, second paragraph.

For at least these reasons, Applicants respectfully request reconsideration and withdrawal of the restriction requirement between Groups I, II, III, IV, and V and respectfully request examination of the claims to the extent necessary to determine patentability of the linking claim.

The foregoing remarks are fully responsive to the Restriction Requirement issued July 9, 2004. Applicants submit that Claims 1 to 55 should be examined together and request rejoinder for the reasons provided above. Early and favorable consideration is earnestly solicited.

If the Examiner believes there are other issues that can be resolved by telephone interview, or that there are any informalities remaining in the application which may be corrected by Examiner's Amendment, a telephone call to the undersigned attorney is respectfully solicited.

Respectfully submitted,



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